

Attorney Docket No.: ISPH-0569
Inventors: Anderson et al.
Serial No.: 09/853,409
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REMARKS

Claims 23-26 and 28-31 are pending in the instant application. Claims 23 and 28-31 have been rejected. Claims 24-26 have been objected to. Claim 28 has been amended. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Double Patenting

The terminal disclaimers filed January 21, 2004 for U.S. Patents 6,423,489 and 6,608,191 state that these patents and the pending application are now wholly owned by Isis Pharmaceuticals, Inc. U.S. Patent No. 6,423,489 was originally assigned to Isis Pharmaceuticals, Inc., Kaketsuken and Mochida Pharmaceutical Co. Ltd. on October 27, 1995. Kaketsuken assigned its rights to Isis Pharmaceuticals, Inc. on February 15, 2000. Mochida Pharmaceutical Co. Ltd. assigned its rights to Isis Pharmaceuticals, Inc. on March 13, 2000. These assignments also cover U.S. Patent No. 6,608,191 since it was a continuation of U.S. Patent No. 6,174,868 and the assignment states that such continuations are also assigned. U.S. Patent No. 6,174,868 was originally assigned to Isis Pharmaceuticals, Inc. and Kaketsuken on June 15, 1998. Kaketsuken

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assigned its rights to Isis Pharmaceuticals, Inc. on February 15, 2000.

Claims 23 and 28 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,174,868. The Examiner suggests that although the conflicting claims are not identical they are not patentably distinct. Applicants have provided herewith a terminal disclaimer that complies with 37 CFR 3.73(b). Accordingly, withdrawal of this rejection is respectfully requested.

Claims 23 and 28 were also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-5 of copending Application No. 10/457,304. The Examiner suggests that although the conflicting claims are not identical they are not patentably distinct from each other. Applicants respectfully request that this rejection be held at abeyance until one of the applications has been allowed as the scope of the claims may change during prosecution.

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II. Rejection of Claims Under 35 U.S.C. 112, Second Paragraph

Claims 28-31 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner suggests that claim 28 recites consisting of language and is unclear how a composition of matter can contain only a single oligonucleotide. The Examiner also suggests that the language referring to subcutaneous administration is unclear. Applicants have amended claim 28 to address these issues. Withdrawal of this rejection is, therefore, respectfully requested.

III. Objection to the Claims

Claims 24-26 have been objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 24-26 depend from claim 23. Applicants believe the rejection of the base claim has been overcome by filing herewith of the terminal disclaimer. Accordingly, claims 24-26 should no longer depend from a rejected

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based claim. Withdrawal of this objection is, therefore, respectfully requested.

IV. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

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